

## **REMARKS**

This paper is filed in response to the Final Office Action mailed on December 12, 2007. In that Office action, claims 1-9, 11-17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being purportedly anticipated by prior art; and claims 10 and 18 are rejected under 35 U.S.C. 103(a) as being purportedly obvious in view of prior art. Applicants respectfully disagree and request reconsideration in light of the following remarks.

### **Claim Rejections – 35 U.S.C. 102**

In the outstanding Office Action, claims 11-17, 19 and 20 stand rejected as being anticipated by U.S. Patent No. 5,702,418 (“Ravenscroft”). Applicants believe that each of the pending claims includes one or more elements that are not disclosed by Ravenscroft, thereby overcoming the aforementioned rejection, as discussed more specifically below.

Independent claims 11, 19 and 20, as well as claims 12-18 dependent upon claim 11, specify an outer shaft, an inner shaft, a rigid inner member, a stepped exterior tube and a catheter. More specifically, the claims clearly recite that the stepped exterior tube comprises a wide diameter end rigidly coupled to the distal end of the outer shaft. Paragraphs [0035] and [0037] recite, among other things, that “the connection between the sheath 96 and the outer shaft 16 is made through the stepped outer tube 92.” Furthermore, the drawings of Figs. 9-11 clearly define boundaries between the stepped exterior tube and the distal end of the outer shaft.

Ravenscroft discloses a stent delivery system having a first handle portion 25, a catheter 11 and a second handle portion 26. On page 2, item 2 of the Office Action, the Examiner asserts that Ravenscroft discloses “an outer shaft 25, an inner shaft 26 coupled to a rigid member 15 having a catheter 17 on its distal end.” Subsequently on page 3, item 6 of the Office Action, the Examiner asserts that “Ravenscroft discloses an outer shaft having a wide diameter end 25 and a smaller diameter end 11.” From these assertions, it is apparent that the Examiner equates the first handle portion 25 of Ravenscroft to both the claimed outer shaft 16 and the claimed wide diameter end 94 of the stepped exterior tube 92. However, the first handle portion 25 cannot be “rigidly coupled” upon itself as recited in the pending claims, and thus, cannot represent both the outer shaft 16 and the wide diameter end 94 of the stepped exterior tube 92. More specifically, Ravenscroft does not disclose or suggest a stepped exterior tube of any kind, let alone a stepped

exterior tube having a wide diameter end being rigidly coupled to the distal end of the outer shaft.

Accordingly, Applicants respectfully submit that each claim of the current claim set includes one or more elements that is not disclosed or suggested by Ravenscroft, and therefore should not be anticipated by same.<sup>1</sup> Consequently, the anticipation rejection asserted against the claims must be withdrawn.

### **Claim Rejection – 35 U.S.C. 103**

In the outstanding Office Action, dependent claim 18 stands rejected under 35 U.S.C. 103 as being obvious over Ravenscroft, in view of U.S. Patent No. 6,176,843 (hereinafter “DiCaprio”). Applicants believe that each of the pending claims includes one or more elements that are not disclosed by the combination of Ravenscroft and DiCaprio, thereby overcoming the obviousness rejection, as discussed more specifically below.

The Examiner asserts that both Ravenscroft and DiCaprio disclose a treatment element delivery device further comprising a valve to flush air from the sheath, as specified in claim 18. As Ravenscroft has been discussed above as failing to disclose the product package specified in the claims at issue, DiCaprio also fails. DiCaprio discloses an inflatable balloon catheter having a guide wire lumen, an inflation lumen and a one-way valve. However, DiCaprio does not disclose an inner shaft slidably disposed within an outer shaft, a rigid inner member or a stepped exterior tube comprising a wide diameter end rigidly coupled to the distal end of the outer shaft and fully enclosing the exterior portion of the rigid inner member in a second position as claimed.

As the combination of Ravenscroft with DiCaprio fails to disclose each and every element of the pending claims at issue, Applicants respectfully submit that the obviousness rejection must fail and should be withdrawn.<sup>2</sup>

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<sup>1</sup> Anticipation under 35 USC §102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention.” *Rockwell International Corp. v. United States*, 47 USPQ2d 1027 (Fed. Cir. 1998).


<sup>2</sup> To support an obviousness rejection, MPEP §2143.03 requires “all words of a claim to be considered” and MPEP § 2141.02 requires consideration of the “[claimed] invention and prior art as a whole.” Further, the Board of Patent Appeals and Interferences recently confirmed that a proper, post-KSR obviousness determination still requires the Office to make “a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art.” See, *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)

**CONCLUSION**

In light of the foregoing, Applicants respectfully submit that each of the currently pending claims, i.e. claims 11-20, are in a condition for allowance and respectfully solicit the same. If a telephone call would expedite prosecution of the subject application, the Examiner is invited to call the undersigned agent. The undersigned verifies that he is authorized to act on behalf of the assignee of the present application.

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Respectfully submitted,

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